

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 30

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES V. YOUNG

Appeal No. 2004-0363
Application No. 09/176,866

ON BRIEF

Before GARRIS, PAK, and OWENS, Administrative Patent Judges.
PAK, Administrative Patent Judge.

REQUEST ON REHEARING

Appellant appears to request a rehearing of the Board's decision entered March 31, 2004, wherein we affirmed the examiner's decision rejecting claims 1 through 7, 9 and 15 through 20 under 35 U.S.C. § 102 or § 103.

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At pages 1 and 2 of the Request for Rehearing dated June 1, 2004, appellant asserts that:

In stating that Holt anticipates claim 1 of the present invention, the Board stated: "Where, as here, there is a reasonable basis to believe that Holt's applicator cavity and connection tube structures are capable of performing the claimed functions, it is incumbent upon the appellant to prove that such structures are not capable of performing the claimed functions. The present record is devoid of such proof." See Opinion, page 8 (citations omitted).

However, the Board has committed clear error in that Applicant has identified that **Holt itself** explicitly indicates that it does not operate in the manner proposed by the Board. Therefore, there **is no** reasonable basis for the Board and the Examiner to conclude that Holt can operate in the manner proposed when **Holt itself says that it cannot.**

...
Holt specifically discloses that contaminants DO NOT travel through the tube 18 of Holt. Precisely, Holt states that:

By using the vibrator in the ordinary manner, dead skin, blackheads and other objectionable material will be loosened, while the suction provided will remove the loosened material and draw the same inward through the openings 26 and 23. **The plate 28 will prevent this material from being drawn into the air passage, the said material being collected within the cup-shaped holder 20.** The applicator 25 and the shell 21 may thereafter be removed and the device thoroughly cleaned [to remove the material [because it was not transferred through the tube]].

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See Holt at page 2, line 57 to line 69.

We do not agree.

Claims 1 and 15, by virtue of using the transitional phrase "comprising" in their preambles, do not preclude the presence of the plate (28) disclosed in Holt in their massage apparatus. See *In re Baxter*, 656 F.2d 679, 686, 210 USPQ 795, 802 (CCPA 1981). Although the claimed **connection tube** is limited by the functional limitation "**capable** of applying at least partial vacuum to the cavity so as to draw and stretch fibrous tissue of the human body within the cavity..." recited in claims 1 and 15, appellant has not demonstrated that such functional limitation would have rendered the claimed connection tube **structurally different** from Holt's connection tub. Rather than pointing to any structure difference between the claimed and Holt's connection tube, appellant points to the plate 28 of Holt which is not part of Holt's connection tube. See the Request for Rehearing dated June 1, 2004, page 2. Thus, we are unconvinced that there was any error in our decision entered March 31, 2004.

Appellant's request for rehearing has been granted to the extent of reconsidering our decision, but is denied with respect to making any changes therein.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

DENIED

Bradley R. Garris

BRADLEY R. GARRIS)
Administrative Patent Judge)

Chung K. Pak

CHUNG K. PAK)
Administrative Patent Judge)

Terry J. Owens

TERRY J. OWENS)
Administrative Patent Judge)

) BOARD OF PATENT
) APPEALS
) AND
) INTERFERENCES

CKP/lp